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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,226	11/22/2000	Taro Inoue	05905.0134	1526
22852	7590	08/19/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				DENNISON, JERRY B
		ART UNIT		PAPER NUMBER
		2143		

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/717,226	INOUE ET AL.
	Examiner J. Bret Dennison	Art Unit 2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on 22 June 2005.
- 2a)  This action is **FINAL**.                                    2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 7-10, 12, 58 and 63-66 is/are pending in the application.
  - 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 7-10, 58 and 63-66 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All    b)  Some \* c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/18/02</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

1. This Action is in response to Application Number 09/717,226 received on 22 June 2005.
2. Claims 7-10, 58, and 63-66 are presented for examination.

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 7-10, 58, 63-66, drawn to accessing a remote server to download files in class 709, subclass 219.
  - II. Claim 12, drawn to program execution and halting in class 717, subclass 127.
2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility for downloading files from a remote server and confirming a successful download, which is separately usable with or without invention II, which provides a device for executing and halting a program. See § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Nathan Sloan (Reg. #56249) on 8/02/2005, a provisional election was made without traverse to prosecute the invention of Group I, claims 7-10, 58, and 63-66. Applicant in replying to this Office action must make affirmation of this election. Claim 12 is withdrawn from further consideration by the Examiner, (See 37 CFR 1.142(b)), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 10 and 66 recite the limitation, "receives data relating to partial files constituting a particular file, and said replying means sends said received data relating to partial files to said server". It is unclear to Examiner what is meant by this limitation, It is unclear how or why the information processing device receives only part of the file and sends it back to the file server. Examiner will interpret the limitation as an interruption occurring during the process and sending a notice to the server about the interruption. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7, 9, 10, 58, 63, 65, and 66 are rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan (U.S. Patent Number 6,460,076).

4. Regarding claims 7 and 63, Srinivasan disclosed an information process device comprising:

connecting means for sending individual information for a user to a file server, in order to connect to said file server (Srinivasan, Fig. 3, "LOG INTO SERVER", "CONFIRM ACCESS AND BILLING INFORMATION", col. 4, lines 24-29);

requesting means for sending a file transmission request relating to a particular file managed by said file server, to said file server (Srinivasan, Fig. 3, "SELECT FILE FROM WEB PAGE", col. 4, lines 30-32);

receiving means for receiving data relating to said particular file as transmitted from said file server in response to said file transmission request (Srinivasan, Fig. 3, "DOWNLOD FILE TO MEMORY IN USER INTERFACE");

judging means for judging whether or not reception of said particular file has been completed (Srinivasan, Fig. 3, "HAS FILE BEEN SUCCESSFULLY TRANSFERRED"); and

notifying means for sending a confirmation message to said file server in order to update the use number data relating to the number of uses by a user as managed by said file server, in cases where it is judged by said judging means that reception has

been completed (Srinivasan, Fig. 3, "SEND CONFIRMATION MESSAGE TO SERVER, col. 3, lines 19-25, col. 4, lines 23-25, col. 7, lines 50-67, Srinivasan disclosed using the confirmation to enforce proper billing to user accounts based on successfully downloaded files).

5. Regarding claims 9 and 65, Srinivasan disclosed the limitations, substantially as claimed, as described in claims 7 and 63, including wherein said information processing device further comprises replying means for sending data relating to the particular file received by said receiving means, to said file server (Srinivasan, Fig. 3, "SEND CONFIRMATION MESSAGE TO SERVER", "FINISH BILLING PROCEDURE").

6. Regarding claims 10 and 66, Srinivasan disclosed the limitations, substantially as claimed, as described in claims 9 and 65, including wherein said receiving means receives data relating to partial files constituting a particular file, and said replying means sends said received data relating to partial files to said file server (Srinivasan, Fig. 3, "SEND NOTICE TO SERVER").

7. Regarding claim 58, Srinivasan disclosed a storage medium storing a computer program for causing a computer system to function as the information processing device according to claim 7 (Srinivasan, col. 2, lines 15-20).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan in view of Haff et al. (U.S. Patent Number 6,219,669).

8. Regarding claims 8 and 64, Srinivasan disclosed the limitations, substantially as claimed, as described in claims 7 and 63. Srinivasan also disclosed sending a notice to the server if an interruption took place during the file transfer (Fig. 3). However, Srinivasan did not explicitly state wherein said receiving means comprises means for receiving data relating to the file size transmitted from said file server; and

    said judging means judges whether or not reception has been completed on the basis of data relating to said file size and data relating to said received particular file.

    In an analogous art, Haff disclosed a file transfer system where the size of the file is checked after transfer to judge whether reception has been completed (Haff, Fig. 4B, 440).

    Therefore it would have been obvious to one in the ordinary skill in the art at the time the invention was made to incorporate checking the file size after downloading to provide immediate and secure assured delivery of files (Haff, col. 5, lines 55-58)

including certified return receipt for the transported files (Haff, col. 6, lines 3-4) to show successful completion of the file transfer (Haff, col. 8, lines 50-60).

### ***Conclusion***

It is presumed that claims 7-10 and 63-66 invoke “means plus function” language and interpretation in accordance with 35 USC 112 sixth paragraph. In order to verify and ascertain the metes and bounds of the claimed invention, Applicant is requested to isolate the portion(s) of the specification which dictates the structure relied on for proper interpretation if this presumption is appropriate.

**Examiner’s Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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